

## REMARKS

This communication responds to the Office Action mailed on May 26, 2006. Claims 1, 6, 10, 13, 15, 20-24, and 27 are amended, no claims are canceled, and no claims are added. As a result, claims 1-28 are now pending in this Application. Claims 10, 13, 21-23, and 27 have been amended to conform to the amendments made to their associated independent claims, and not for reasons related to patentability.

### §102 Rejection of the Claims

Claims 1-8, 13-17, 19-22, 24-26 and 28 were rejected under 35 USC § 102(b) as being anticipated by Anderson (U.S. 6,161,013; hereinafter “Anderson”). The Applicant does not admit that Anderson is prior art and reserves the right to swear behind these references at a later date. In addition, because the Applicant asserts that the Office has not established a *prima facie* case of anticipation, the Applicant traverses this rejection of the claims.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

With respect to claims 1, 6, 15, 20, and 24, the Office asserts that Anderson discloses “downloading ... a demodulation code” or “a module to download a demodulation code”. However, a careful reading of Anderson reveals this assertion to be incorrect.

Anderson teaches downloading “information regarding the identities of neighboring base stations 104 (including **spread spectrum code set** and frequency information) from the

originating base station 405 ... to the user station 102 during traffic mode or otherwise.” *See* Anderson, Col. 15, lines 62-67. However, a spread spectrum code set is not the same as what is claimed by the Applicant.

The Applicant claims “*downloading a demodulation code to direct operations of a signal processor to demodulate the second information received from the second network upon receiving an indication of a beneficial connection*” (claims 1 and 15), “*downloading to the device a demodulation code to direct operations of a signal processor to demodulate information associated with the second protocol, wherein the device includes one of a dedicated search receiver and a multiplexed search receiver to measure channel characteristics associated with the benefit, and wherein the downloading occurs upon receiving an indication of a beneficial connection*” (claim 6), and “*the receiver comprising one of a dedicated search receiver and a multiplexed search receiver to measure channel characteristics associated with the second network and the benefit; a module to download a demodulation code to demodulate the second information upon receiving an indication of a beneficial connection; and a signal processor to couple to the receiver and to the module to download the demodulation code, wherein the demodulation code is to direct operations of the signal processor to demodulate the second information*” (claims 20 and 24).

As noted in the Application, the “... apparatus 240, 348 may include a module 270, 370, such as a modulator, demodulator, or both, perhaps comprising a signal processor, operated by accessing the code 266, 366.” Application, para. [0018]. The spread spectrum code set of Anderson are not the same as a code (set of instructions), which when downloaded and accessed, directs a signal processor to demodulate a signal.

Therefore, since Anderson does not teach the identical invention claimed, it is believed that independent claims 1, 6, 15, 20, and 24 (as well as all claims depending from them) are in condition for allowance. Reconsideration and withdrawal of the rejection of claims 1-8, 13-17, 19-22, 24-26, and 28 under § 102 is respectfully requested.

§103 Rejection of the Claims

Claims 9-12, 23, and 27 were rejected under 35 USC § 103(a) as being unpatentable over Anderson in view of Sagi et al. (U.S. 2004/0264410; hereinafter “Sagi”). Claim 18 was also

rejected under 35 USC § 103(a) as being unpatentable over Anderson in view of Jagadeesan et al. (U.S. 2005/0059400; hereinafter “Jagadeesan”). First, the Applicant does not admit that Anderson, Sagi, or Jagadeesan are prior art, and reserves the right to swear behind these references in the future. Second, since a *prima facie* case of obviousness has not been properly established in each case, the Applicant respectfully traverses these rejections.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.* The M.P.E.P. contains explicit direction to the Examiner that agrees with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant=s disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d (BNA) 1443 (Fed. Cir. 1992). However, while it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979)). The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which notes that the motivation must be supported by evidence in the record.

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No proper *prima facie* case of obviousness has been established because (1) combining the references does not teach all of the limitations set forth in the claims, and (2) combining the references provides no reasonable expectation of success. Each of these points will be explained in detail, as follows.

**Combining References Does Not Teach All Limitations:** First, with respect to independent claims 6, 15, 20, and 24, no combination suggested in the Office Action will render all of the claim limitations. In a prior Office Action, the Office admitted that Jagadeesan fails to disclose “downloading a demodulation code” or “a module to download a demodulation code” as claimed by the Applicant. Anderson, as noted above, has the same deficiency.

Neither has the Office alleged that Sagi includes the missing elements, and no evidence was found by the Applicant to the contrary. Therefore no combination of Anderson, Sagi, and Jagadeesan can provide these claimed elements, and independent claims 6, 15, 20, and 24 are nonobvious. This conclusion applies to all dependent claims since any claim depending from a nonobvious independent claim is also nonobvious. See M.P.E.P. § 2143.03.

**No Reasonable Expectation of Success:** Modifying Anderson to include the networks and receivers of Sagi, or the pecuniary relationship of Jagadeesan will not provide an operative combination, since neither Sagi nor Jagadeesan teach downloading a demodulation code. One of ordinary skill in the art would not expect that accessing the downloaded spread spectrum code set of Anderson would provide “*a demodulation code to direct operations of a signal processor to demodulate*” or apparatus/systems “*wherein the demodulation code is to direct operations of the signal processor to demodulate*”, as claimed by the Applicant.

Therefore, since there is no evidence in the record that combining Anderson, Sagi, or Jagadeesan results in apparatus or methods that operate to download demodulation codes capable of directing the operations of a signal processor, and since no reasonable expectation of success arises, a *prima facie* case of obviousness has not been established with respect to independent claims 6, 15, 20, and 24, or for any of the claims that depend from them. It is therefore respectfully requested that the rejections of claims 9-12, 23, and 27 under 35 U.S.C. § 103 be reconsidered and withdrawn.

**CONCLUSION**

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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